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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 21

Application Number: 09/193,787
Filing Date: November 17, 1998
Appellant(s): DRUMMOND ET AL.

Ralph E. Jocke (Reg. No.31,029)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 01/17/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

Appellant stated that there are no related appeals or interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that no groups of claims stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

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✓5905248	Russell et al.	5-1999
✓4337864	McLean	7-1982
✓5436435	McMillan	7-1995

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The step recited must be clearly and positively specified. The step must be organized and correlated in such a manner as to present a complete operative method.

Claims 1-6, 8-13,16, 22-26 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5933816 to Zeanah et al.

Zeanah et al. disclose an automated banking machine (see col. 3, lines 60-62), including an output device, wherein the output device outputs information, whereby a user is enable to perceive outputs from the output device; an input device, wherein the input device is operative to receive inputs, whereby a user is enabled to provide inputs to the machine; a transaction function device, wherein the transaction function device is selectively operative to carry out a transaction (see col. 9, lines 8-14); a computer, wherein the computer is in operative connection with the output device, the input device, and the transaction function device, software executable in the computer, wherein the software includes a browser, wherein the browser is operative to process

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HTML documents including instructions therein, and wherein the transaction function device is operative to carry out the transaction function responsive to the browser processing at least one document including at least one instruction adapted to cause the computer to cause operation of the transaction function device (see col. 5, lines 44-54; col. 9, lines 8-14; col. 14, lines 49-54; col. 32, lines 48-57). Note. A web browser software is installed in the computer (see col. 5, lines 50-53) for at least receiving financial services request. It is known that web browsers are software application used to locate and display web pages; hence, "processing HTML documents".

Referring to claims 2-6, Zeanah et al. disclose the system, wherein the transaction function device includes a sheet dispenser, card reader, printer, depository and keyboard (see col. 9, lines 8-14). Although, Zeanah et al. do not explicitly state that a keyboard is an element of the system, it is illustrated in figure 1, reference character 18. Also Zeanah et al. discloses a computer, and it is known that computers comprise keyboards (see col. 3, lines 60-61).

Referring to claim 8, Zeanah et al. disclose a computer; a browser operating in the computer (see col. 5, lines 44-53); a transaction function device in operative connection with the computer, wherein the transaction function device is operative to cause the ATM to carry out a transaction responsive to at least one HTML format document that is received by the browser (see col. 9, lines 8-14; col. 14, lines 49-54; col. 32, lines 48-57). Notice, the ATM includes a web browser (see col. 5, lines 50-53), it is known that web browsers are software application used to locate and display web pages (i.e. "HTML documents").

Referring to claim 9, Zeanah et al. disclose operating a browser in at least one computer in connection with an automated banking machine (see fig. 1, reference characters 18 and 16; col. 5, lines 44-53); notice, the computer is in connection with the ATM; receiving at least one

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HTML format document with the browser, wherein the at least one HTML format document includes at least one transaction instruction; carrying out at least one transaction function with a transaction function device in the automated banking machine responsive to the at least one HTML format document (see col. 9, lines 8-14; col. 14, lines 49-54; col. 32, lines 48-57).

Notice, the ATM includes a web browser (see col. 5, lines 50-53), it is known that web browsers are software application used to locate and display web pages (i.e. "HTML documents").

Referring to claim 10, Zeanah et al. disclose an automated banking machine including an output device in operative connection with the computer, and further comprising the step of producing an output through the output device responsive to the execution of at least one HTML format document (see col. 5, lines 50-53; col. 9, lines 8-14; col. 14, lines 49-54; col. 32, lines 48-57). Notice, the ATM includes a web browser (see col. 5, lines 50-53), it is known that web browsers are software application used to locate and display web pages (i.e. "HTML documents").

Referring to claim 11, Zeanah et al. disclose operating a browser in at least one computer in operative connection with an automated banking machine (see fig. 1, reference characters 18 and 16; col. 5, lines 44-53); notice, the computer is in operative connection with the ATM; receiving at least one document with the browser, wherein the document includes at least one transaction instruction embedded therein; carrying out at least one transaction function with a transaction function device in the automated banking machine responsive to the at least one document (see col. 9, lines 8-14; col. 14, lines 49-54; col. 32, lines 48-57).

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Referring to claim 12, Zeanah et al. disclose an ATM that operates to conduct at least one financial transaction responsive to at least one mark-up language document (see col. 5, lines 44-53; col. 14, lines 49-54; col. 32, lines 48-57).

Referring to claim 13, Zeanah et al. disclose a computer in operative connection with the banking machine (see fig. 1, reference characters 18 and 16; col. 5, lines 44-53); notice, the computer is in operative connection with the ATM; at least one transaction function device in the banking machine adapted to carry out at least a portion of a banking transaction; wherein the computer is adapted to cause at least one banking transaction to be carried out through operation of the at least one transaction function device responsive to at least one mark up language (see col. 9, lines 8-14; col. 14, lines 49-54; col. 32, lines 48-57).

Referring to claim 16, Zeanah et al. disclose providing an automated banking machine including at least one transaction function device (see col. 5, lines 44-53; col. 9, lines 9-18), wherein the automated banking machine is in operative connection with at least one computer (see fig. 1, reference characters 18 and 16; col. 5, lines 44-53); notice, the computer is in operative connection with the ATM. Zeanah et al. also disclose processing at least one mark up language document with the computer, carrying out at least a portion of a banking transaction with the transaction function device responsive to processing the at least one mark up language document with the computer (see col. 5, lines 44-54; col. 9, lines 8-14; col. 14, lines 49-54; col. 32, lines 48-57). Note. A web browser software is installed in the computer (see col. 5, lines 50-53) for at least receiving financial services request. It is known that web browsers are software application used to locate and display web pages; hence, "processing HTML documents".

Referring to claim 22, Zeanah et al. disclose a banking machine including at least one output device, and further comprising the step of: producing an output through the output device responsive to the processing of at least one mark up language document with the computer (see col. 9, lines 8-14; col. 14, lines 49-54; col. 32, lines 48-57). Notice, the computer includes a web browser (see col. 5, lines 44-53), it is known that web browsers are software application used to locate and display web pages (i.e. "HTML documents").

Referring to claim 23, Zeanah et al. disclose the method, wherein the computer includes browser software, and wherein the at least one output is provided responsive to the browser software processing the at least one mark up language document (see col. 9, lines 8-14; col. 14, lines 49-54; col. 32, lines 48-57). Notice, the computer includes a web browser (see col. 5, lines 44-53), it is known that web browsers are software application used to locate and display web pages (i.e. "HTML documents").

Referring to claim 24, Zeanah et al. disclose the method, wherein the output device includes a screen and wherein the at least one output includes a visual output through the screen (see col. 9, lines 8-14; col. 24, lines 39-46).

Referring to claim 25, Zeanah et al. disclose the method, wherein at least one HTML document is processed by the (see col. 14, lines 49-54; col. 32, lines 48-57). Note, the computer includes a web browser (see col. 5, lines 44-53); it is known that web browsers are software application used to locate and display web pages (i.e. "HTML documents").

Referring to claim 26, Zeanah et al. disclose a method, wherein the automated banking machine includes an output device, and wherein the step of processing the at least one markup language document is operative to cause the computer to provide an output through the output

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device and to carry out at least the portion of the banking transaction (see col. 9, lines 8-14; col. 14, lines 49-54; col. 32, lines 48-57). Notice, the computer includes a web browser (see col. 5, lines 44-53), it is known that web browsers are software application used to locate and display web pages (i.e. "HTML documents").

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zeanah et al. as applied to claim 1 above, and further in view of U.S. Patent No. 5905248 to Russell et al.

Zeanah et al. disclose a software (see col. 5, lines 50-53). Zeanah et al. do not expressly disclose a software that is operative responsive to an instruction to access at least one HTTP record address (i.e. "URL"), wherein the at least one HTTP record address corresponds to at least one HTTP record (i.e. "HTML document") including instructions adapted to cause the computer to cause operation of the transaction function device. Russell et al. disclose a software that is operative responsive to an instruction to access at least one HTTP record address (i.e. "URL"), wherein the at least one HTTP record address corresponds to at least one HTTP record (i.e. "HTML document") including instructions adapted to cause the computer to cause operation of the transaction function device (see col. 2, lines 21-23, col. 3, lines 20-24 and col. 21, lines 43-45). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the software disclose by Zeanah et al. wherein the software is operative responsive to an instruction to access a HTTP record address wherein the HTTP record address corresponds to a HTTP record including instructions adapted to cause the computer cause operation of the transaction function device. One of ordinary skill in the art would have been motivated to do this because it allows the user to access the web to perform transactions;

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further, HTTP is the primary protocol used by the World Wide Web, which defines what actions web browsers should take in response to various commands.

Claim 14, 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zeanah et al. as applied to claim 13 above, and further in view of Russell et al.

Zeanah et al. disclose a computer including a software (see col. 5, lines 44-53). Zeanah et al. do not disclose a computer including a document handling software. Russell et al. discloses a system wherein the computer includes document handling software, and wherein the computer is operative to carry out the at least one banking transaction responsive to the document handling software processing the at least one mark up language document (see col. 25, lines 34-40). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the software disclose by Zeanah et al. to include a document handling software, and wherein the computer is operative to carry out the at least one banking transaction responsive to the document handling software processing the at least one mark up language document. One of ordinary skill in the art would have been motivated to do this because a document handling software manages a document file and enables performing various kinds of operations.

Referring to claim 28, Russell et al. disclose an apparatus, wherein the document handling software includes a browser, wherein the computer is adapted to automatically operate at least one transaction function device responsive to the processing of at least one mark up language document with the document handling software (see col. 6, lines 39-46 and col. 21, lines 43-45). At the time the invention was made, it would have been obvious to a person of

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ordinary skill in the art to develop a method wherein the computer is operative to cause the carrying out of the banking transaction responsive to at least one software applet. One of ordinary skill in the art would have been motivated to do this because web browsers can interpret applets from web servers.

Referring to claim 30, Russell et al. discloses an apparatus, including a display device having a display screen (see col. 18, lines 12-20), wherein the computer includes document handling software wherein the computer is operative to automatically display at least one visual output through the display device responsive to processing at least one mark up language document with the computer (see col. 6, lines 39-46). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the apparatus disclosed by Zeanah et al. to include a display device having a display screen, wherein the computer includes document handling software wherein the computer is operative to automatically display at least one visual output through the display device responsive to processing at least one mark up language document with the computer. One of ordinary skill in the art would have been motivated to do this because it provides additional output.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zeanah et al. and Russell et al. as applied to claim 28 above, and further in view of U.S. Patent No. 4337864 to McLean.

Zeanah et al. disclose an ATM having a currency dispenser (see col. 9, lines 9-18). However, Zeanah et al. do not expressly disclose the currency sheet dispensing at least one note. McLean discloses a method, wherein the transaction function device includes a currency sheet dispenser, and wherein the at least one banking transaction includes dispensing at least one from the

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currency sheet from the currency sheet dispenser (see col. 6, lines 66-68; col. 7, lines 1-4 and col. 8, line 37-38). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the currency sheet dispenser disclose by Zeanah et al. to dispense at least on currency sheet. One of ordinary skill in the art would have been motivated to do this because it provides currency to the user.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zeanah et al. as applied to claim 13 above, and further in view of U.S. Patent No. 4337864 to McLean.

Zeanah et al. disclose an ATM having a cash dispenser (see col. 9, lines 9-18). However, Zeanah et al. do not expressly disclose the note dispenser dispensing at least one note. McLean discloses a method, wherein the transaction function device includes a note dispenser, and wherein the at least one banking transaction includes dispensing at least one from the note dispenser (see col. 6, lines 66-68; col. 7, lines 1-4 and col. 8, line 37-38). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the cash dispenser disclose by Zeanah et al. to dispense at least on note. One of ordinary skill in the art would have been motivated to do this because it provides cash to the user.

Claims 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zeanah et al. as applied to claim 16 above, and further in view of McLean.

Zeanah et al. disclose an ATM having a cash dispenser (see col. 9, lines 9-18). However, Zeanah et al. do not expressly disclose the note dispenser dispensing at least one note. McLean discloses a method, wherein the transaction function device includes a note dispenser, and wherein the at least one banking transaction includes dispensing at least one from the note dispenser (see col. 6, lines 66-68; col. 7, lines 1-4 and col. 8, line 37-38). At the time the

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invention was made, it would have been obvious to a person of ordinary skill in the art to modify the cash dispenser disclose by Zeanah et al. to dispense at least on note. One of ordinary skill in the art would have been motivated to do this because it provides cash to the user.

Claim 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zeanah et al. as applied to claim 16 above, and further in view of U.S. Patent No. 5436435 to McMillan.

Zeanah et al. discloses an ATM comprising a card reader. Zeanah et al. do not expressly disclose the card reader reading the indicia from the card or reading indicia with the reading device. McMillan discloses an ATM, wherein the transaction function device includes at least one reader device, wherein in the portion of the transaction includes reading indicia with the reading device and wherein the reading device includes a card reader, wherein the indicia is read from a card (see fig. 2; col. 4, lines 36-38). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the card reader disclose by Zeanah et al. to read the indicia from a card. One of ordinary skill in the art would have been motivated to do this because this is an essential components an automated banking machine; that is, a card reader device identifies the encrypted data imprinted on the card and provides additional security.

Referring to claim 20, McMillan discloses the ATM, wherein the transaction function device includes at least one key, and wherein the portion of the banking transaction includes sensing an input through the at least one key (see col. 4, lines 53-58). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Zeanah et al. to include an the ATM, wherein the transaction function device

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includes at least one key, and wherein the portion of the banking transaction includes sensing an input through the at least one key. One of ordinary skill in the art would have been motivated to do this because it provides verification; thus, additional security.

Referring to claim 21, McMillan discloses the depository, wherein the portion of the banking transaction includes receiving a deposit with the depository (see col. 4, lines 7-9). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclose by Zeanah et al. to include the depository, wherein the portion of the banking transaction includes receiving a deposit with the depository. One of ordinary skill in the art would have been motivated to do this because it provides convenience.

(11) *Response to Argument*

Applicant's arguments filed 01/17/03 have been fully considered but they are not persuasive.

35 USC § 112, 2nd paragraph

Appellant argues that claim 27 is not indefinite; however, the examiner disagrees. That is, claim 27 is imprecise; the computer of claim 16 performs the step of carrying out at least a portion of a banking transaction with the transaction function device responsive to processing at least one mark up language document, and claim 27 (which depends on claim 16) utilizes said computer to perform the step of carrying out of the portion of the banking transaction responsive to at least one software applet. Thus, the computer is carrying out a portion of a banking transaction processing both the markup language document and a software applet. The examiner believes that the computer must perform the banking transaction responsive to either the markup

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language or the software applet, not both. Also, claim 27 does not further limit claim 16 but instead complicates it, making it confusing to the reader. Appellant is advised to consider revising the claim 27 for clarity.

35 USC § 102 (e)

Appellant argues that Zeanah et al. does not constitute prior art because Applicant's swears back prior to July 1996, and that Zeanah et al. is not entitled to the Oct. 31, 1996 filing date of provisional application 60/029,209.

In response, the examiner cannot consider arguments that attempt to invalidate a patent. Every patent is presumed to be valid, 35 U.S.C. 282, first sentence. Public policy demands that every employee of the United States Patent and Trademark Office (USPTO) refuse to express to any person any opinion as to the validity or invalidity of, or the patentability or unpatentability of any claim in any U.S. patent, except to the extent necessary to carry out

(A) an examination of a reissue application of the patent,

(B) a reexamination proceeding to reexamine the patent, or

(C) an interference involving the patent.

The question of validity or invalidity is otherwise exclusively a matter to be determined by a court (see MPEP 1701). Thus, examiner presumes that the patent to Zeanah et al. is valid and furthermore that Zeanah is entitled to the priority date (October 31, 1996) of the provisional application 60/029,209 of which Zeanah et al. claim priority.

Moreover, if the examiner made a determination that Zeanah et al.'s patent is not entitled to the provisional application date of October 31, 1996, then possibly a prior art rejection may be

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made towards Zeanah et al.; hence invalidating the patent. The examiner refuses to make such assumption and further considers all patents valid, including Zeanah et al.

As per claims 1-6,8-13,16, and 22-26, Appellant argues that Zeanah et al.'s browser does not include software that is capable of performing transaction device instruction processing. However, the examiner disagrees, Zeanah et al. disclose a system (10) for providing financial services. The system (10) comprises a delivery system (12) for providing services to various remote devices including ATM (16), CAT/CASST terminal, PC (18); wherein the remote devices are installed with software such as a web browser for communicating with the delivery system. Note. It is known in that web browsers are software application used to locate and display web pages; hence, "processing HTML documents". Also, the delivery system (12) includes transaction executor components (91) for performing business functions such as cash withdrawal, deposits, transfers etc.

One embodiment of Zeanah et al. system is as follows:

"At step E41, the customer selects a mini-app with the touch point and display component 31 and the request is sent into the delivery system 12. At step E42, the presentation manager component 52 demultiplexes the request based on mimetype and URL and sends the request to the navigation shell component 82. A step E43, the navigation shell component 82 instantiates the appropriate mini-app dialog component 83. At step E44, the mini-app dialog component 83 returns choices to the customer. At step E45, a back and forth dialog occurs between the customer and the mini-app dialog component 83 until all information is collected for a function...At step E46, after all information has been collected, the min-app dialog component 83 instantiates the transaction executor component 91 for the selected function. At step E47, the

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transaction executor component 91 formats a message to the external service provider 22 and does the transaction with the external service provider 22.” (see col. 21, lines 12-32).

Also see col. 21, lines 47-52

Notice, the customer uses a browser to communicate with the delivery system, the browser displays the mini-app [HTML doc.] to the user for selection. After receiving the list of choices the customer provides appropriate information regarding the transaction; once all the information is collected the min-app instantiates the transaction executor component for the selected function, the transaction executor component formats a message to the external provider and does the transaction (see col. 14, lines 49-57 for the types of transaction executor components). Further, the above citation and explanation [and those used in paper #18] clearly illustrates a transaction function device operating responsive to a browser processing an HTML document instruction.

As per claims 2-6, 8-13, 16, and 22-26 see above response.

35 USC § 103

As per claim 7, Appellant posed the question “where does Russell teach or suggest the relationship of software and an HTTP record having instructions adapted to cause operation of a transaction function device” Appellant is advised to see *Grounds for Rejection* above.

As per claims 14, 15, 17 and 28-30, see response to 35 USC 102(e) arguments above and *Grounds for Rejection*. It is clear that Zeanah et al. disclose the process of performing a transaction responsive to processing at least one markup language. The specific step of “dispensing at least one note/currency” was not explicitly taught by Zeanah et al. but can be presumed. However, the examiner utilized the McLean reference, which discloses “dispensing

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at least a note/currency” along with Zeanah et al.; thus, these references combine teaches the claimed invention.

As per arguments regarding claims 18-21, please see *Grounds for Rejection* above, which illustrates that using Zeanah et al. in view of McMillan teach the claimed methods.

Reduction to Practice

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Zeanah et al. reference to either a constructive reduction to practice or an actual reduction to practice. Appellant claims that conception or a reduction to practice occurred prior to July 7, 1996, however, the showing of facts submitted does not support Applicant's claim.

The declaration is signed by less than all named inventors of the application. A declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection (See MPEP 715.04(B)). In this application, the Appellant states that he is the sole inventor of at least claims 1-4, 6-19 and 22-27 only, however, all the claims (1-20) are under rejection. The facts set forth in the declaration seem to pertain to the subject matter of claims 1-4, 6-19 and 22-27, when the reference were cited in the rejection of all claims (claims 1-30 as discussed above). The declaration, even though signed by fewer than all the joint inventors, must show completion of the invention by all the joint inventors of the subject matter of the claim(s) under rejection (See MPEP 715.04). Since the claims under rejection are claims 1-30,

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the applicant must show completion of the subject matter of all the claims by the joint inventors since the claims recite different subject matter.

For the above reasons, it is believed that the rejections should be sustained.

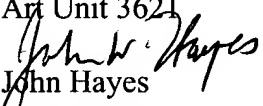
Respectfully submitted,

JW

February 25, 2003

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